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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,081	03/29/2001	Messaoud Benantar	AUS920010141US1	5342

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/821,081	Applicant(s) BENANTAR ET AL.	
	Examiner Minh Dieu Nguyen	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 2, 5, 8, 11, 12, 15, 18, 21, 22, 25 and 28** are rejected under 35 U.S.C. 102(e) as being anticipated by Creighton et al. (2002/0035686).

a) **As to claims 1, 11 and 21**, Creighton discloses a method and system for issuing digital certificates as online credentials to business partners in an extranet comprising: generating a pre-registration record for the user (page 4, paragraph [0036]); sending the pre-registration record as an e-mail attachment in an e-mail message to the user (page 4, paragraph [0036]); generating at the client a cryptographic key pair comprising a user private key and a user public key (page 1, paragraph [0005]); sending

a PKI credential request for the PKI credentials to a certificate issuing authority, wherein the public key certificate request comprises the pre-registration record and the user public key; and receiving the PKI credentials at the client (page 2, paragraph [0011]).

b) **As to claims 2, 12 and 22**, the examiner takes official notice that the use of retrieving user information from a directory and storing them into the pre-registration record are known in the data communication arts.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the implementation of retrieved data to may be stored or used in any desired manner in the system of Creighton so as to make the efficient use of data.

c) **As to claims 5, 15 and 25**, Creighton discloses the method further comprising prompting the user for user authentication data (user identification code and PIN) to be included in an attribute certificate (page 4, paragraph [0036]) and storing the user authentication data in the PKI credential request (page 4, paragraph [0036]).

d) **As to claims 8, 18 and 28**, Creighton discloses the method wherein the PKI credentials comprise a public key certificate for the user and an attribute certificate for the user (page 4, paragraph [0037]).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 3, 9, 13, 19, 23 and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Creighton et al. (2002/0035686) in view of Padgett et al. (6,535,978).

a) **As to claims 3, 13 and 23**, Creighton discloses the method further comprising viewing the e-mail messages within a browser, wherein the browser generates the crypto key pair (Fig. 2; page 1, paragraph [0005]). Creighton does not explicitly disclose storing the user private key in a secure local keystore at the client.

Padgett discloses storing the user private key in a secure local keystore at the client.(Fig. 1). It is known in the public key encryption that the public key is used for encryption and public key can be freely distributed, the private key is for decryption, therefore the private key needs to be kept secret.

b) **As to claims 9, 19 and 29**, Creighton does not disclose publishing PKI credentials in a directory.

Padgett discloses PKI credentials are sent to a public directory (col. 7, lines 4-5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of storing PKI credentials to a directory in the system of Creighton so as to easily access to all certificates.

6. **Claims 4, 10, 14, 20, 24 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Creighton et al. (2002/0035686) in view of Brown et al. (6,671,805).

a) **As to claims 4, 14 and 24**, Creighton does not disclose e-mail message is formatted according to an S/MIME standard.

Brown discloses all transmissions over the network employ the Secure Multipurpose Internet Extension (S/MIME) (col. 16, lines 15-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of S/MIME in the system of Creighton so as to enhanced network security.

b) **As to claims 10, 20 and 30**, Creighton does not disclose the PKI credentials are formatted according to an X.509 standard.

Brown discloses ANSI X.509 standard is used for digital certificates (col. 14, lines 35-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of X.509 standard for digital certificates in the system of Creighton so as to strengthen authentication across networks.

7. **Claims 6, 16 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Creighton et al. (2002/0035686) in view of Schneider (2002/0010745).

Creighton does not disclose retrieving a URI from the e-mail message and posting the public key certificate request to the certificate issuing authority using the URI.

Schneider discloses generating URI having a query portion that uses the e-mail addresses or contact information of the intended recipient as a search request to retrieve more contact information (Figs. 3a and 3b).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of URI in the system of Creighton so as to get more contact information.

8. **Claims 7, 17 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Creighton et al. (2002/0035686) in view of Stewart et al. (6,571,221).

Creighton does not disclose storing the PKI credentials in a secure local keystore at the client.

Stewart discloses a network communication service with an improved subscriber model wherein a digital certificate is stored on the mobile user's portable computing device (col. 2 , lines 57-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of storing PKI credentials in a secure local keystore at the client in the system of Creighton so as to allow client direct access to the network.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 703-305-9727. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 703-306-3036. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Minh Dieu Nguyen
Examiner
Art Unit 2137

mdn
9/24/04

Andrew Caldwell
Andrew Caldwell